

REMARKS

Claims 1-35 are pending in this application. Claim 1 has been amended by this Amendment.

The Office Action dated July 28, 2004 rejected claim 1 as being indefinite under 35 USC 112, first paragraph; rejected claims 1-3, 5, 6, 9, 10, 12, 19, 20, 22, 23, 25 and 29-34 as being anticipated by prior art under 35 USC 102(e); and rejected claims 4, 11, 24 and 35 as being rendered obvious by prior art under 35 USC 103. Applicants gratefully acknowledge the indication that claims 7, 8, 13-18, 21 and 26-28 are allowable.

Indefiniteness Rejection

The grounds for the rejection of claim 1 as being indefinite under 35 USC 112, first paragraph, is set forth in part 3 on page 2 of the Office Action. The rejection points out unclear language in the claim. Applicants have amended claim 1 to clarify the language addressed in the rejection.

Anticipation Rejection

The grounds for the anticipation rejection of claims 1-3, 5, 6, 9, 10, 12, 19, 20, 22, 23, 25 and 29-34 as being anticipated by prior art under 35 USC 102(e) is set forth in part 5 on pages 3-6 of the Office Action. Specifically, the rejection asserts that the claims are anticipated by the network in Fig. 1 of U.S. Patent No. 5,970,059 issued to Ahopelto et al (the network hereinafter being referred to simply as “Ahopelto”). Applicants respectfully traverse the rejection at least because it does not establish that Ahopelto includes each and every one of the combination of features recited in the rejected claims.

First and foremost, independent claims 1 and 6 are directed to subscribers in packet-switched telephony networks. The background on pages 1-6 of the specification explains the differences and incompatibilities between packet switched telephony networks and cellular networks. Indeed, the description of cellular networks on pages 5-6 specifically refers to a GSM cellular network. The networks of Operator 1 and Operator 2 in Ahopelto are GSM

cellular networks and are not IP packet-switched telephony networks. Although there is an IP Network shown in the middle of Fig. 1 between the two GSM networks of Operator 1 and Operator 2, it is merely available to pass data between the two GSM network and does not include the recited features related to subscribers.

Secondly, Ahopelto does not include a visited function in a packet-switched telephony network or a packet-switched telephony network home function. The rejection refers to the GPRS support node of the GSM/GPRS networks of Operator 1 and Operator 2, but these elements are not a visited function in a packet-switched telephony network or a packet-switched telephony network home function.

Furthermore, the rejection asserts that Ahopelto anticipates the recited feature of sending a message to the packet-switched telephony network home function that provides a packet-switched telephony network address of the visited function. The rejection refers to col. 5, line 60, to col. 6, line 6 of the patent as “inherently” performing this feature. Again, beyond Ahopelto not involving a packet-switched telephony network, a visited function or a home function, the cited portion of the patent merely refers to an identifier. There is no indication that the identifier is a packet-switched telephony network address, which is what independent claims 1 and 6 require to be sent.

Obviousness Rejections

The grounds for the obviousness rejection of dependent claims 4, 11, 24 and 35 are set forth in parts 7 and 8 on pages 6-8 of the Office Action. Specifically, the rejection acknowledges that Ahopelto does not have the features of the rejected claims, but asserts that since the features are known from the secondary references, one of ordinary skill in the art would have implemented them into Ahopelto.

Applicants respectfully traverse the obviousness rejections because the motivation given to support the proposed narrow modification of Ahopelto is not fairly suggested by the secondary references. The rejections merely note that the missing features of the dependent claims are present in the embodiments of the secondary references, and apparently asserts that

ATTY DOCKET NO. 6173/33US

only these features would be taken from the secondary references and inserted into Ahopelto. The rejection fails to address the comments in the background of each secondary reference which do not support the proposed modification.

Please charge any fees due in connection with the filing of this Amendment, to Deposit Account No. 02-4270 (Dkt. No. 6173-33US) and please credit any overpayment or excess fees to such deposit account.

Respectfully submitted,



Robert M. Bauer, Registration No. 34,487
Brown Raysman Millstein Felder & Steiner, LLP
900 Third Avenue
New York, NY 10022
Tel.: (212) 895-2000
Fax: (212) 895-2900